

REMARKS

This Response and the following remarks are intended to fully respond to the Advisory Action dated August 15, 2008 and Final Office Action dated June 6, 2008. Claims 1, 3, 8, 9, and 12-14 are currently amended. No claims are currently cancelled, and claims 16-17 were previously withdrawn. Claims 1-15 and 18-25 are currently pending.

Applicants respectfully request reconsideration and withdrawal of the pending rejection in light of the foregoing amendments and following remarks.

Rejection under 35 U.S.C. § 112, First Paragraph

Claims 1-15 and 18-25 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse the rejection and do not concede any characterizations of the pending application or claims set forth in the Office Action.

In order to expedite prosecution of the application, Applicants have amended the claims so that “at least one spacer” now reads “a spacer.” These amendments are intended to address concern over the written description requirement. They are not intended to narrow the scope of the claims in any way.

Applicants respectfully request withdrawal of the pending rejection.

Rejection of Claims 1-3, 5, 6, 9, 13, and 18-23

Claims 1-3, 5, 6, 9, 13, and 18-23 were rejected as being obvious over Dahm et al. (U.S. Patent No. 6,399,394) in view of Lyman (U.S. Patent No. 6,555,361). Applicants respectfully traverse the rejection and do not concede any characterizations of the pending application or cited references set forth in the Office Action.

The pending claims are not obvious because references fail to teach or suggest all of the claimed elements. Even if they did, the references teach away from each other. At the very least, Dahm would have to be modified in such a way that its structure would not satisfactorily work for its intended purpose.

The mere fact that references can be combined does not make the combination obvious. KSR Int'l v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007). Whether a prior art reference teaches away from the combination is "a significant factor to be considered in determining obviousness." M.P.E.P. § 2145 (X)(D)(1). A reference teaches away from the claimed combination when one skilled in the art would be "discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was actually taken by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). Stated another way, "[A] reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." Id.; see In re Caldwell, 319 F.2d 254, 256, 138 USPQ 243, 245 (CCPA 1963) (reference teaches away if it leaves the impression that the combination will not have the property sought by applicant).

Advisory Action

The Advisory Action dated August 15, 2008 states, "Dahm et al yields no statement that the height of the spacer is required to be higher than the height of the gasket; rather, column 9 merely states that the studs 50 (i.e., the spacers of the instant claims) 'help in guiding substrate 10 into correct registration with gasket 60' and thus makes no mention of the requirement of any height whatsoever with respect to the guiding into correct registration." Page 4, Section III(B)(1). This statement suggests that Dahm cannot teach away from the claimed invention

because it does explicitly teach that the stud 50 is taller than the gasket. Page 4, Section B(1).

As demonstrated by the cases cited above, however, it is well settled that such an explicit disclosure is not required for the reference to teach away from the claimed invention. A reference sufficiently teaches away from a claimed invention if: (1) one skilled in the art would be discouraged from following the path set out by the applicant, (2) one skilled in the art would be led in a direction different from the direction taken by the applicant, or (3) using the development from the reference's disclosure would not be productive of the result sought by the applicant. As examined in more detail below, the references fall into all three of these categories and teach away from the claimed invention.

Pending Claims

Claim 1 recites, "a thermoplastic substrate comprising a front side [and] a back side . . . at least one gasket interposed between said slide and said front side of the substrate; and at least one spacer interposed between said slide and said from side of the substrate." The height of the spacer "is less than the height of the at least one gasket."

Cited References

Neither Dahm nor Lyman teach that the spacer is interposed between a slide and the substrate. Indeed, Dahm and Lyman even teach away from such a combination.

Dahm discloses a substrate 10 carrying an array, which corresponds to a slide. Col. 8, lines 16-19. The substrate 10 and a gasket 60 are positioned between a cover 30 and a plate 80. Studs 50 guide gasket 60 to aid in correctly registering it with respect to cover 30, by fitting in the gaps between adjacent gasket ports portions. See col. 9, lines 34-36. Studs 50 also are positioned to be just outside the perimeter of substrate 10 and help in guiding substrate 10 into correct registration with gasket 60. See col. 9, lines 36-39.

Because studs 50 are used to guide substrate 10 into correct registration with gasket 60, studs 50 naturally have a height greater than gasket 60 so they can engage the side of the substrate when it is positioned over the gasket and cover and guide it into position. Therefore, Dahm directly teaches away from a spacer having a height less than a gasket and cannot be combined with another reference to form an obviousness rejection of the claimed combination of structures in claim 1.

Lyman teaches bottom portion 14 having two raised oval rings 26 and 28 that define a groove for holding an o-ring. Clamps 24 engage the bottom portion 14 and the top portion 12 by compression fit on the o-ring. Lyman then teaches, "Further, the interior most of the raised rings 28 defines a contained region 32 that is sized to receive a glass microscope slide and forms the floor of the interior chamber." Col. 3, lines 17-20. Lyman teaches that the slide must fit within a cavity defined by the spacer and hence the o-ring, which teaches away from the gasket and the spacer being disposed between the slide and the substrate.

No combination of Dahm and Lyman teach or suggest a spacer interposed between the slide and the substrate. Indeed, the references actually teach away from such a structure. Therefore, Applicants respectfully submit that the pending claims are not obvious over the cited references and request withdrawal of the pending rejection.

Rejection of Claims 4, 7, 8, 10-12, 14, 15, 24, and 25

Claims 4 and 7 were rejected as being obvious over Dahm in view of Lyman and further in view of Dickinson et al. (U.S. Pat. Pub. No. 2002/0102578). Claims 8 and 12 were rejected as being obvious over Dahm in view of Lyman and further in view of Gallagher et al. (U.S. Pat. Pub. No. 2003/0064507). Claims 10, 11, 24, and 25 were rejected as being obvious over Dahm in view of Lyman and further in view of Frye et al. (U.S. Patent No. 6,272,939). Claim 14 was

rejected as being obvious over Dahm in view of Lyman and further in view of Wilding et al. (U.S. Patent No. 5,587,128). Claim 15 was rejected as being obvious over Dahm in view of Lyman in view of Frye and further in view of Wilding. Claim 23 was rejected as being obvious over Dahm in view of Lyman and further in view of Mogard et al. (U.S. Patent No. 6,216,905). Claims 24 and 25 were rejected as being obvious over Dahm in view of Lyman in view of Frye and further in view of Mogard. Applicants respectfully traverse these rejections and do not concede any characterizations of the pending application or cited references set forth in the Office Action.

Claims 4, 7, 8, 10-12, 14, 15, 24, and 25 depend from claim 1 and also include the limitation that the gasket and the spacer are interposed between the slide and the substrate, and that the height of the spacer is less than the height of the gasket. As discussed above, Dahm teaches away from this element and thus cannot be combined with prior art to establish obviousness of a claimed combination that includes this structure. The other references cited in these rejections also fail to teach or suggest this element. Therefore, no combination of these references will result in the claimed invention.

Applicants respectfully submit that claims 4, 7, 8, 10-12, 14, 15, 24, and 25 are patentably distinct from the cited reference and request withdrawal of the pending rejections.

CONCLUSION

In view of the above amendments and remarks, Applicants respectfully submit that the claims are patentably distinct from the cited reference and request issuance of a Notice of Allowance. Applicants note that there may be reasons that the pending claims are patentably distinct from the cited references in addition to those set forth herein. Applicants reserve the right to raise any such reason in the future. If Examiner believes a telephone conference would

advance the prosecution of this application, Examiner is invited to telephone the undersigned at the below-listed telephone number.


Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'John C. Reich', written over a horizontal line.

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